

DETAILED ACTION

1. In view of the Appeal Brief filed on October 26, 2009, **prosecution is hereby reopened.**

2. A new ground of rejection is set forth below.

3. To avoid abandonment of the application, appellant must exercise one of the following two options: (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

4. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.

/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434

This office action has been issued in response to the Appeal Brief Filed October 26, 2009 and includes Amendments to the claims which have been entered as per the July 27, 2009 Amendment After Final. Accordingly Claims 1, 2, 4-6, 8-15, 18, and 20-24 are currently pending, in which claims 1, 5-6, and 8-9 are in independent form.

Status of Claims:

Claims 1-2, 4-6, 8-15, 18, and 20-24 are rejected under 35 U.S.C. 103(a).

Response to Amendment

Applicant's July 27, 2009 Amendment After Final to the Claims have been received and entered, in which claims 1, 5, 6, 8, 9, 20, 23, and 24, are amended, and claim 19 is cancelled. Applicant's Argument included in the Appeal Brief Filed October 26, 2009 is responded to below.

Response to Arguments

Based on Applicant's persuasive Argument included in the Appeal Brief Filed October 26, 2009, an additional search was performed pertaining to "region codes" and their usage. Having found pertinent prior art, Examiner is reopening prosecution on this application. Accordingly, a Non Final Office Action containing new grounds of rejection is prepared and shown below with respect to Applicant's amendments.

35 USC § 112, 6th Paragraph

1. The following is a quotation of 35 U.S.C. 112, 6th Paragraph:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

2. The language of multiple elements within independent claim 6 recited the means-plus-function language and invoked 35 U.S.C. 112, sixth paragraph. These claim elements of independent claim 6 contain the "means for" phrase, and are modified by the following functional language respectively: "retrieving memory medium properties ..."; "authenticating said memory medium ..."; and "determining that the memory

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medium ...". Additionally, they are not modified by sufficient structure and thereby are being treated under 35 U.S.C. 112, sixth paragraph.

3. No other claims and/or claim elements invoke 35 U.S.C. 112, sixth paragraph.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2, 4-6, 8-15, and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al, (U. S. Patent Number WO 01/90860 A2), hereinafter Schwartz, in view of Collart (U.S. Patent Number 6,405,203).

As to claim 1, the following is taught: "A communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of:

extracting memory medium properties from the memory medium inserted in the device, sending said memory medium properties to the remote unit, authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, and determining that the memory medium is

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illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; page 4, lines 4-8; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments);

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 1, but fails to teach: region codes and their usage. However, Collart teaches “wherein the memory medium properties include a region code of the memory medium” (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart’s teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium’s authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 2, the following is taught: “The communication method as claimed in claim 1, wherein the memory medium properties are written in a control data zone of the memory medium.” (Schwartz teaches: Abstract, Detailed Description of the Preferred Embodiment: page 4, lines 4-8; page 5, lines 6-11; See claims starting page 16).

As to claim 4, the following is taught: “The communication method as claimed in claim 1, wherein the remote unit is able to send different types of additional data as a function of the memory medium properties.” (Schwartz teaches: Detailed Description of the Preferred Embodiment: page 13, line 27 to page 14, line 2; See claims starting page 16).

As to claim 5, the following is taught: “A communication system comprising a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said device and the remote unit communicating via a network, wherein the remote unit is able to retrieve memory medium properties from the memory medium inserted in the device, to authenticate said memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to said device and to determine that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; page 4, lines 4-8; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments);

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 5, but fails to teach: region codes and their usage. However, Collart teaches “wherein the memory medium properties include a region code of the memory

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medium” (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart’s teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium’s authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 6, the following is taught: “A remote unit for communicating with a device able to read a memory medium, the remote unit comprising additional data for the memory medium, means for retrieving memory medium properties from the memory medium inserted in the device, means for authenticating said memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to said device and means for determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory includes identical content for rendering as the corresponding memory medium” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 5, lines 6-11; page 5, lines 20-22; page 14; See claims starting page 16; also see Response to Arguments).

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 6, but fails to teach: region codes and their usage. However, Collart teaches “wherein the memory medium properties include a region code of the memory medium” (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart's teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium's authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 8, the following is taught: “A computer readable medium embodying a computer program comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of: extracting memory medium properties from the memory medium inserted in the device, sending said memory medium properties to the remote unit, and determining that the memory medium is illegally produced when the memory medium properties are different from corresponding properties of a corresponding memory medium legally produced by a provider even if the memory medium includes identical content for rendering as the

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corresponding memory medium.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 3, lines 1-10; page 5, lines 9-11; page 5 line 26 to page 12, line 26; page 14; See claims starting page 16; also see Response to Arguments).

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 8, but fails to teach: region codes and their usage. However, Collart teaches “wherein the memory medium properties include a region code of the memory medium” (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart’s teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium’s authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 9, the following is taught: “A computer readable medium embodying a computer program comprising program instructions for implementing, when said program is executed by a processor, a communication method via a network between a device able to read a memory medium, and a remote unit comprising additional data for the memory medium, said communication method comprising the acts of: retrieving memory medium properties from the memory medium inserted in the device,

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authenticating the memory medium by comparing said memory medium properties with corresponding properties of a corresponding memory medium legally produced by a provider, before sending the additional data to the device, and determining that the memory medium is illegally produced when the memory medium properties are different from the corresponding properties even if the memory medium includes identical content for rendering as the corresponding memory medium.” (Schwartz teaches: Abstract; Summary of Invention: page 1, lines 22, to page 2, line 8; page 2, lines 10-12; Detailed Description of the Preferred Embodiment: page 5, lines 6-11; page 5, lines 20-22; page 5, line 26 to page 12, line 26; page 14; See claims starting page 16; also see Response to Arguments).

As to the above parenthesized references, Schwartz teaches the referenced elements of claim 9, but fails to teach: region codes and their usage. However, Collart teaches “wherein the memory medium properties include a region code of the memory medium” (region code, storage; Collart: Abstract; column 19, lines 21-25; column 25, lines 58-62).

In view of Collart’s teachings regarding region codes and their usage, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include region codes and their usage in determining the memory medium’s authenticity. Although these specifics are not recited by Schwartz, one would be motivated to use any and all region code usage techniques in order to provide for proper and legal data reproducing, and prevent illegal copying of recorded data.

As to claim 10, the following is taught: “The communication method of claim 1, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 11, the following is taught: “The communication method of claim 1, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 12, the following is taught: “The communication system of claim 5, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 13, the following is taught: “The communication system of claim 5, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 14, the following is taught: “The remote unit of claim 6, wherein the memory medium comprises at least one read-only, recordable, and rewritable discs

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(Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 15, the following is taught: “The remote unit of claim 6, wherein the memory medium comprises at least one of a DVD, CD, DVD, and Blu-ray discs (Schwartz: Abstract; Field of Invention: page 1 lines 1-8; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21; See claims starting page 16).

As to claim 20, the following is taught: “The communication method of claim 1, wherein the additional data includes advertisement depending on the region code” (advertising; Collart: Abstract; Figures 8, 9; column 4, lines 35-38; column 16, lines 54-57; column 20, line 26; column 21, line 16).

As to claim 21, the following is taught: “The communication method of claim 1, further comprising the act of allowing recording of the additional data if the authenticating act is successful” (Schwartz: Abstract; Summary of Invention: page 1, lines 19-25; page 2, lines 18-21).

As to claim 22, the following is taught: “The communication method of claim 1, further comprising the act of allowing access to the additional data only while the memory medium is being played in the device” (Schwartz: Abstract; page 1, line 19 to page 2, line 17; page 5, lines 20-27; page 12, line 16).

As to claim 23, the following is taught: "The communication system of claim 5, wherein the additional data includes advertisement depending on the region code" (advertising; Collart: Abstract; Figures 8, 9; column 4, lines 35-38; column 16, lines 54-57; column 20, line 26; column 21, line 16).

As to claim 24, the following is taught: "The remote unit of claim 6, wherein the additional data includes advertisement depending on the region code" (advertising; Collart: Abstract; Figures 8, 9; column 4, lines 35-38; column 16, lines 54-57; column 20, line 26; column 21, line 16).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al, (U. S. Patent Number WO 01/90860 A2), hereinafter Schwartz, in view of Collart (U.S. Patent Number 6,405,203), in further view of Valente et al (U.S. Publication Number 2003/0110192 A1), hereinafter Valente.

As to claim 18, the following is taught: "The communication method of claim 1 (See claim 1 above).

As to the above parenthesized references, Schwartz, and Collart teach the referenced elements of claim 18, but fails to teach: “blacklisting the device if the remote unit receives a number of requests higher than a predetermined threshold from the device containing a non-authenticated memory medium”. However, Valente teaches blacklisting a device after it exceeds a number of attempts of “illegal” operations and renders device incapable of conducting further activities (Valente: page 6, paragraph [0070]). In view of Valente’s teachings regarding blacklisting techniques, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to specifically include blacklisting techniques in determining device authentication. Although these specifics are not recited by Schwartz, and Collart, one would be motivated to use any and all blacklisting techniques in order to provide for better and faster authentication management, and prevent illegal copying of recorded data.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEPHEN SANDERS whose telephone number is (571)270-5308. The examiner can normally be reached on M - F; 7:30a.m. - 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Kambiz Zand can be reached on 571-272-3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen Sanders/
Examiner, Art Unit 2434
/Kambiz Zand/

Supervisory Patent Examiner, Art Unit 2434